

198009US2S

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#9/Election
Shawn
RECEIVED 8-19-02

AUG 13 2002

TECHNOLOGY CENTER 2800

IN RE APPLICATION OF:

:

Toshiya IMAI, et al.

: EXAMINER: EASTHOM, K

SERIAL NO: 09/677,886

:

FILED: OCTOBER 3, 2000

: GROUP: 2832

FOR: NONLINEAR RESISTOR AND METHOD
OF MANUFACTURING THE SAME

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER OF PATENTS
WASHINGTON, DC 20231

SIR:

In response to the Election of Species Requirement stated in the Official Action dated July 11, 2002, Applicants provisionally elect Species 17, as shown in Sample 17 in Table 1, and identify Claims 3-8 and 11 as readable on the elected species.

Applicants respectfully traverse the outstanding election requirement for several reasons.

First, the outstanding Office Action asserts that "[t]his application contains claims directed to the ... patentably distinct species of the claimed invention...." However, MPEP §816 states the following:

If the particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

The outstanding Election Requirement merely provides the aforementioned conclusory statement and does not present particular reasons for such a holding. Hence, Applicants respectfully submit that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §816.

Further, MPEP §806.04(f) states:

Claims to be restricted to different species must be mutually exclusive.

The outstanding Election Requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicants further traverse the Election Requirement.

Furthermore, MPEP §803 states the following:

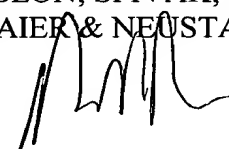
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Claims 8 and 14 of the present application are directed to a non-linear resistor. Thus, it appears that all claims in the present application are part of an overlapping search area and that a search for Claims 3-8 and 11 would necessarily include a search directed to the claims readable on the non-elected species as well. Applicants therefore respectfully submit that there is no undue burden on the Examiner to search all the claims under MPEP §803, and traverses the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 3-20 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No: 25,599
Robert T. Pous
Registration No: 29,099
Attorneys of Record



22850

Tel: (703) 413-3000
Fax: (703) 413-2220
GJM/RTP/AY:si
I:\ATTY\AKY\19s\198009\elect.wpd



RECEIVED

AUG 13 2002

TECHNOLOGY CENTER 2800

Docket No.: 198009US2S



ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

ATTORNEYS AT LAW

GREGORY J. MAIER
(703) 413-3000
GMAIER@OBLON.COM

ROBERT T. POUS
(703) 413-3000
RPOUS@OBLON.COM

RE: Application Serial No.: 09/677,886

Applicants: Toshiya IMAI, et al.

Filing Date: October 3, 2000

For: NONLINEAR RESISTOR AND METHOD OF
MANUFACTURING THE SAME

Group Art Unit: 2832

Examiner: EASTHOM, K

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier

Registration No. 25,599

Robert T. Pous

Registration No. 29,099



22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)
I:\USER\SIIZA\19S\198009\ELECT_CVR.DOC